

Appl. No. 10/764,835

REMARKS

This submission is a response to the Office Action mailed July 26, 2006 (the Office Action), in which all claims were rejected on grounds discussed further below. No claims are amended, added or canceled herein. Consequently, claims 61 to 78 remain pending for the Examiner's reconsideration. Applicant respectfully traverses the rejection of all claims in this application. The Examiner's review and reconsideration of this application in light of the following remarks is courteously requested.

Claims 61, 62, and 71 – 35 U.S.C. 103(a): Maurille, Skelly

Claims 61, 62, and 71 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille (USP 6,484,196) in view of Skelly (USP 6,064,383). Specifically, the office action asserts that Maurille discloses, in the context of a chat session:

receiving a set of sequences of keystrokes, mouse actions, or keystrokes and mouse actions.

The Office Action further asserts that Skelly discloses:

detecting whether a mnemonic name is present in said sequence of keystrokes, mouse actions, or keystrokes and mouse actions, said mnemonic name being associated with one of a set of multimedia objects;

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when said mnemonic is detected in said sequence, replacing said mnemonic name with said multimedia object in said set of sequences; and

wherein said set of multimedia objects are associated with an ensemble, said ensemble having a set of ensemble properties.

Finally, the Office Action asserts that one skilled in the art is provided motivation to combine the teachings of Maurille and Skelly in order to obtain the invention claimed in claims 61, 62, and 71. In what immediately follows, applicant demonstrates that in general Skelly does not teach each of the claim elements as asserted in the Office Action. Specifically, Skelly fails to teach "replacing said mnemonic name with said multimedia object in said set of sequences".

It should initially be noted that the sections of Skelly highlighted in the Office Action are actually references not to the teachings of Skelly itself, but to a then-pending patent application that has now issued as USP 6,069,622 (Kurlander). Applicant will refer interchangeably to Skelly and Kurlander herein.

Applicant has previously summarized the present invention this way: According to one embodiment of the present invention, in the context of a standard, text-based inter-client chat, certain words, phrases or punctuation are actually replaced within the text sentences by multimedia objects (images, sounds, executable code, etc.) to provide a more engaging chat experience than pure text. Claim 61 contains the limitation "when said mnemonic name is detected in said set of sequences, replacing said mnemonic name with said multimedia object in said set of sequences". (Claim 61, lines 7-8, emphasis added. See also, claim 70, lines 6-8, discussed further below.)


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It is admitted in the Office Action that Maurille fails to teach or suggest replacing a mnemonic name with a multimedia object, as claimed. It is, however, asserted in the Office Action that Skelly teaches such a feature at col. 1, lines 53-65. It is this proposition with which applicant respectfully disagrees.

According to Skelly/Kurlander, text is converted into a comic strip, with portions of the text appearing in conversation or thought bubbles over images of characters representing the communicants. According to Kurlander, the conversation is examined, and if certain text or characters are located therein, the character is rendered with expressions, actions, background, etc. corresponding to the identified text or characters. As an example from Kurlander, pane 700 of Fig. 7 shows a character saying "I'm from Ohio." This text is analyzed, and first the character is made to point to himself, and second a map of Ohio is placed in the background. (See col. 8, lines 35-54.) Importantly, the text "I'm from Ohio" appears above the character. Nothing is removed or replaced in that text.¹

There is nothing in Skelly (or Kurlander) which suggests that a portion of a sequence of characters is detected, and that portion of the sequences of characters removed and replaced by a multimedia object in the sequence of characters.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180

¹ As an example of how applicant's invention might deal with such a phrase in the context of chat, the word "Ohio" might be identified and replaced by a map of Ohio within that sentence: "I'm from Ohio" thus becoming "I'm from  as it is presented to a chat participant.

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USPQ 580 (CCPA 1974).” M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). The burden is on the Examiner in the first instance to explain how the prior art suggests and motivates the combination of the prior art so as to produce each limitation. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990).

Despite the conclusory statement in the Office Action that Skelly teaches such a limitation, applicant has demonstrated that it does not. Thus, since neither Maurille nor Skelly/Kurlander teach or suggest replacing a portion of text with a multimedia object within the context of that text, the combination cannot produce such a limitation. Accordingly, the invention of claim 61 is patentably distinct from the cited references, taken alone and in combination. Accordingly, applicant respectfully requests reconsideration and allowance of claim 61.

As claim 62 directly depends from and contains all of the limitations of claim 61, it must be patentably distinct from the cited references for at least the reasons that claim 61 are distinct therefrom. Accordingly, applicant also respectfully requests reconsideration and allowance of claim 62.

Claim 71 depends from and contains all of the limitations of claim 70. Claim 70, like claim 61, contains the limitation “a detector capable of detecting at least one of said mnemonic names in said set of sequences and of replacing said mnemonic name with at least one corresponding multimedia object in said set of sequences” (claim 70, lines 6-8, emphasis added). For the reasons enumerated above, the combination of Maurille and Skelly/Kurlander fail to teach or suggest such a limitation. Thus, claim 70 is

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patentably distinct from that combination of references, as is claim 71 by its dependence on claim 70.

For the sake of being explicit about our reasoning, by its dependence on claim 70, claim 71 contains the limitation "a detector capable of detecting at least one of said mnemonic names in said set of sequences and of replacing said mnemonic name with at least one corresponding multimedia object in said set of sequences". The cited combination of references fails to teach such a limitation. As there is at least one limitation not taught or suggested by the references, no prima facie case of obviousness has been made. In re Royka, supra. Accordingly, applicant respectfully requests reconsideration and allowance of claim 71.

Claims 63-70 and 72-78 – 35 U.S.C. 103(a): Maurille, Skelly, Liles

Claims 63-70 and 72-78 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille (USP 6,484,196) in view of Skelly (USP 6,064,383) and further in view of Liles (USP 5,880,731). Applicant explains below that Liles further fails to teach or suggest replacing a portion of a sequence of characters with a multimedia object in the sequence of characters, and that the invention of the base independent claims has not been shown by the combination of references. Applicant will then address the rejections of the individual claims.

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As with Skelly and Kurlander, Liles (same Assignee) is directed to a chat program in which participants are represented by characters (avatars) on screen. A user selects an avatar of choice. The system presents renderings of that avatar which convey information to supplement the chat communication. In particular, Liles is concerned with the gestures portion of this system. Once again, there is nothing in Liles which teaches or suggests detecting a portion of a sequence of characters and replacing that detected portion with a multimedia object in the sequence of characters. In fact, those sections of Liles which reference chat text make it clear that such text is transmitted in full to the other participants. See, e.g., col. 10, lines 2-25. Accordingly, each of Maurille, Skelly, and Liles fail to teach or suggest detecting a portion of a sequence of characters and replacing that detected portion with a multimedia object in the sequence of characters, and accordingly the combination must fail to teach or suggest such a limitation.

Now, with respect to the rejections of the claims, we begin with a discussion of claim 61. As mentioned above, claim 61 contains the limitation "when said mnemonic name is detected in said set of sequences, replacing said mnemonic name with said one multimedia object in said set of sequences" (claim 61, lines 7-8, emphasis added). However, it has also been shown above that the combination of Maurille, Skelly, and Liles fails to teach or suggest this limitation. Accordingly, claim 61 is patentably distinct from the combination of Maurille, Skelly, and Liles. Now, claims 63-69 depend either directly or indirectly from claim 61, and therefore contain all of the limitations of claim

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61. Thus, claims 63-69 must be patentably distinct from the cited references for at least the reasons that claim 61 are distinct therefrom.

To be clear, by way of their dependence on claim 61, claims 63-69 contain the limitation that "when said mnemonic name is detected in said set of sequences, replacing said mnemonic name with said one multimedia object in said set of sequences". This limitation is nowhere taught or suggested by the combination of cited references. As there is at least one limitation not taught or suggested by the references, no prima facie case of obviousness has been made. In re Royka, supra. Accordingly, and without discussing the specific limitations of each claim in this group, applicant respectfully requests reconsideration and allowance of claims 63-69.

Similarly, claim 70 contains the limitation "a detector capable of detecting at least one of said mnemonic names in said set of sequences and of replacing said mnemonic name with at least one corresponding multimedia object in said set of sequences" (claim 70, lines 6-8, emphasis added). However, we have shown above that the combination of Maurille, Skelly, and Liles fails to teach or suggest this limitation. Accordingly, claim 70 is patentably distinct from the combination of Maurille, Skelly, and Liles, and applicant respectfully request reconsideration and allowance of claim 70 on these grounds.

Furthermore, claims 72-78 depend either directly or indirectly from claim 70, and therefore contain all of the limitations of claim 70. Thus, claims 72-78 must be

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patentably distinct from the cited references for at least the reasons that claim 70 are distinct therefrom.

To be clear, by way of their dependence on claim 70, claims 72-78 contain the limitation "a detector capable of detecting at least one of said mnemonic names in said set of sequences and of replacing said mnemonic name with at least one corresponding multimedia object in said set of sequences". This limitation is nowhere taught or suggested by the combination of cited references. As there is at least one limitation not taught or suggested by the references, no prima facie case of obviousness has been made. In re Royka, supra. Accordingly, and without discussing the specific limitations of each claim in this group, applicant respectfully requests reconsideration and allowance of claims 72-78.

Conclusion

Applicant recognizes and appreciates the reasoning behind the rejections in the Office Action. However, for the foregoing reasons, the claims of the present application are asserted to be patentably distinct from the cited references, taken alone or in combination. Thus, the present application is believed to be in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

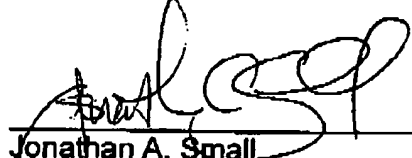
By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably

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distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,



Jonathan A. Small
Attorney for Applicant(s)
Registration No. 32,631

Telephone: 650-941-4470

343 Second St., Suite F
Los Altos, California

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